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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/962,271	10/31/1997	GARY A. FREEMAN	04644/068001	8658

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EXAMINER

FOSTER, JIMMY G

ART UNIT

PAPER NUMBER

3728

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3✓

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/962,271

Applicant(s)
Freeman et al.

Examiner
Jimmy G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 20, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 18, 20-23, 26, 27, and 29-51 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 18, 20-23, 26, 27, and 29-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed since specific amendments to the claims have been made which were not addressed by the declaration of April 6, 2000 or by the original declaration.

Claim 1-12, 14, 18, 20-23, 26, 27, 29-51 are therefore rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

2. Claims 1-12, 14, 18, 20-22 and 49-51 otherwise patentably distinguish over the prior art and will be allowable when Applicant files the appropriate supplemental declaration, overcoming the above rejection.

3. Claims 23, 26, 27, and 29-48 are finally rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998);

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In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. **See MPEP 1412.02.**

To attempt to achieve allowance on April 27, 1995, claim 15 of the original application, which became patent claim 16, was amended by Applicant to add a limitation, "a releasable seal adapted to seal said compartment and maintain", with the term "maintain" referring to the already existent limitation, "...said electrode in a sealed mode". Applicant also added a limitation that a barrier element was positioned at the releasable seal. The claim had not previously included a limitation regarding a releasable seal. The added limitations to claim 15 were referred to in the Applicant's arguments. These changes were made in accordance with the agreement prior interview of April 10, 1995 (Interview Summary, paper 5). In response to the amendment of claim 15, the art rejection was withdrawn by the examiner and the claim was allowed. Reissue claims 23, 26, 27, and 29-48 are missing this limitation with respect to a releasable seal. The

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reissue claims 23, 26, 27, and 29-48 are also missing the limitation with respect to the barrier element being positioned at the releasable seal.

Inasmuch as the limitations that are missing in claims 23, 26, 27, and 29-48 are ones Applicant had relied upon for allowance of said claim 15, it is asserted that Applicant is now trying to improperly recapture subject matter that Applicant had surrendered to achieve the allowance.

4. Claims 23, 26, 27, and 29-48 distinguish over the prior art. However, indication of patentable subject matter in these claims has been withheld in view of rejection under 35 U.S.C. 251 set forth in paragraph 3, above.

5. Applicant's arguments filed February 20, 2002 have been fully considered but they are not persuasive.

The dispute in this case is primarily with respect to the meaning of a paragraph in the decision, Hester Industries Inc. v. Stein Inc. (CAFC) 46 USPQ2d 1641, at 1649-1650. The court states:

Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. See e.g., *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the

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recapture rule."); *Clement*, 131 F3d. at 1470, 45 USPQ2d at 1165. For example in *Ball*, the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

The Applicant has relied on this paragraph to assert that when a reissue claim omits a limitation which had been added to the original claims in order to secure allowance by distinguishing over the applied prior art which had been used to reject the claims, the omission of the added limitation avoids the effects of the recapture rule if the claim is materially narrowed with regard to a different, overlooked aspect of the invention.

The examiner disagrees with this interpretation of the decision paragraph, above.

The recapture rule exception for "overlooked aspects of the invention" is only mentioned in the next-to-last sentence of said paragraph. That sentence starts with the words, "[i]n the context of surrender by way of argument". The portion of the paragraph before the next-to-last sentence only presents a legal

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history regarding decisions which have permitted avoidance of the recapture rule for broadened reissue claims.

1) There is the citation regarding the decision Mentor Corp v. Coloplast Inc. 998 F.2d at 996, 27 USPQ2d at 1525. Looking to the page of that decision cited, the discussion involved how the recapture rule will not apply if the reissue claims are broader than the original patent claims only in a way that is not directly pertinent to the subject matter surrendered.

2) There is the citation regarding the decision of In re Clement, 131 F3d. at 1470, 45 USPQ2d at 1165. Looking to the page for the Clement decision cited, the discussion involved how the effect of the recapture rule could be avoided even if the reissue broadened the claim over a "canceled" claim, so long as it was evident that the "canceled" claim had not been canceled (i.e. replaced by a claim with an added limitation or amended by adding a limitation) to avoid a rejection over the prior art. That is, an added limitation does not necessarily constitute surrendered subject matter where it had not been made to distinguish the claim over the applied prior art.

3) The discussion on the page cited for the decision Ball Corporation v. United States, 729 F.2d at 1438, 221 USPQ at 296, held that a reissue claim was permitted to be narrower than the "canceled" claims even if they are broader than the patented claims in a non-material way.

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Accordingly none of the legal history provided in the Hester paragraph includes the situation discussed in the last two sentences of the paragraph: which concerns avoiding the effect of the recapture rule on the basis that Applicant is now claiming "overlooked aspects of the invention", even though the limitation relied on to avoid the prior art and achieve the patent has now been deleted in the reissue claims.

The examiner disagrees that this exception extends to surrendered subject matter in canceled claims or in amended patented claims wherein the cancellation or amendment was made to avoid a prior art rejection. An amendment to add a limitation is an active, selective and deliberate act. "The [recapture] rule is rooted in the 'error' requirement in that such a surrender is not the type of correctable 'error' contemplated in the reissue statute." Hester Industries Inc. v. Stein Inc. (CAFC) 46 USPQ2d 1641, at 1647. In the examiner's view, the "overlooked aspects" exception only extends to the situation in which surrender of subject matter is by argument(s) alone, as indicated in the last two sentences of the Hester paragraph.

Hester does not give too much detail why the exception is made, except to state, "[t]he purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects." (CAFC) 46 USPQ2d at 1650. It is noted that this explanation does not appear to indicate why a distinction is made for *arguments alone* as compared to an amendment or a

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cancellation accompanied by such arguments. Perhaps when arguments are made alone, they are often in response to a rejection which the examiner subsequently discovers is inadequately founded or is in error. The arguments made may likely depend on the inadequacy of the rejection, with the poorer rejection inequitably engendering a more comprehensive argument.

Moreover, with arguments alone there is no cancellation of subject matter by the Applicant. It would appear that argument alone is harder to analyze, as indicated in Ball Corporation v. United States, 729 F.2d at 1438, 221 USPQ 289, 295, footnote 19.

The Hester decision was the first decision to have to undertake the problem in which arguments alone constituted improper recapture by reissue of surrendered subject matter. This is perhaps another reason to interpret the overlooked aspects exception to the recapture rule as only involving surrender by argument alone.

Accordingly, the examiner is unpersuaded by Applicant's arguments.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire

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on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. For contacting the PTO by phone, the following contact numbers may be used:

For tracking of papers and association of papers with cases --

Customer Service. . . (703)306-5648

For matters regarding examination -- Examiner:

Jim Foster (703)308-1505

For faxing of correspondence:

Draft amendments only-(703)308-7769

(Examiner should be notified of fax)

Formal correspondence-(703)305-3579 or 305-3580

RIGHT FAX-Before Final . . (703) 872-9302

-After Final . . . (703) 872-9303

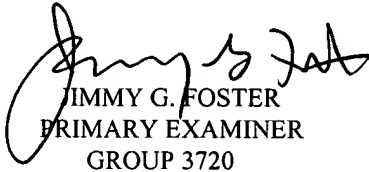
(The examiner ordinarily will not retrieve formal correspondence)

For petitions:

Before the Examiner . (703)308-1505

Before the Director . (703)308-3872

Other petitions . . . (703)305-9282


JIMMY G. FOSTER
PRIMARY EXAMINER
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May 17, 2002